

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

<i>In re</i> Application of :)	Confirmation No. 7890
)	
Thomas P. MURPHY, <i>et al.</i>)	Examiner: Jeffrey D. Carlson
)	
Serial No.: 09/735,446)	Group Art Unit: 3622
)	
Filed: December 13, 2001)	
)	
For: SYSTEM AND METHOD FOR		
REMOTELY PROVIDING		
INCENTIVES TO PURCHASERS		

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to This brief is in reply the Examiner's Answer dated January 16, 2007

Appellants enclose a Reply Brief under 37 C.F.R. § 41.41. Applicants submit that the Reply Brief is in full compliance with the requirements of 37 C.F.R. 41.37. Appellants respectfully request that the Reply Brief be accepted and further that the Board of Patent Appeals and Interferences reconsider and withdraw the rejections of record, and allow the pending claims, which are attached hereto.

STATUS OF CLAIMS

Claims 1-28 are pending in the application and were finally rejected in a Final Office Action dated May 14, 2004. The final rejection of claims 1-28 is hereby appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellants find error in each of the outstanding rejections and requests that each ground of rejection in the Final Office Action be reviewed. The rejections presented in the Final Office Action are as follows:

A. Claims 1-28 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,330,543 to Kepecs ("Kepecs") in view of U.S. Patent No. 5,794,207 to Walker *et al* ("Walker *et al.*").

ARGUMENT

Appellants respectfully traverse the art rejection applied against the claims now pending on appeal. As discussed below, the Examiner has not met the burden of proof in establishing the obviousness of the appealed claims. Applicants respectfully submit that the rejection ignores limitations recited in the claims and relies on art that neither discloses nor suggests, individually or collectively, to one skilled in the art the claimed invention. In particular, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness in each of the independent claims, that is claims 1, 7, 13, 18, 23 and 26.

To establish a *prima facie* case of obviousness, the Examiner must provide a basis for the proposed modification of the reference teachings to result in the claimed invention, and provide convincing rationale therefor. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). In the present case, the Examiner has failed to provide sufficient factual basis or rationale as to how features of the present invention as recited in claims 1-28 are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Also, Applicants note that the combination of applied references is an attempt at rejecting claim features with divergent reference merely because they are alleged to collectively disclose claim features regardless of whether there would be any motivation to make the combination besides that of improper hindsight reconstruction. The '543 patent is directed to system for viewing incentives online, such as coupons or discounts that are selected by the viewer. The '207 patent is directed to the Priceline business where viewers make conditional purchase offers. The system of the claim invention allows the viewer to suggest an incentive, and the system determines whether the incentive can and/or should be provided to the viewer. If so, the viewer

is prompted to pay for the incentive, only if he/she wants the incentive. Furthermore, the viewer is not agreeing to purchase the underlying good. If the good is purchased, the costs of the incentive may be refunded. This type of system is not obvious in view of the collective teachings of the '543 and '207 patents.

i. Claim 1-6

In relevant portion, claim 1 recites an online method for presenting one or more incentives offered by an offeror and relating to associated goods or services to a user for viewing a remote terminal, comprising, *inter alia*,

(e) upon receiving information from the remote user relating to parameters of a selected incentive, the central location generating at least one incentive data file, the incentive data file relating to the user selected incentive parameters and comprising a plurality of fields, including a redemption amount field, a user identification field, and an associated good or service identification field, the redemption amount field representing the value of the incentive offered to the user;

(f) transmitting from the central location to the user at the remote terminal a prompt for payment of a user fee associated with disbursement of a redeemable certificate related to the incentive data file, receiving at the central location information from the user sufficient to effect payment of the user fee;

In the rejection of this claim the Examiner completely ignores the method step (e) of the claim. The rejection fails to identify how either the '543 or '207 patents generate at least one incentive file or perform a function that is so substantially similar, to render this claim step obvious in view of the combined teachings of the '543 and '207 patents. Moreover, regarding method step (f), the Examiner takes Official Notice that it would have been obvious to have,

“...charged users for services and to refund fees if the users follow through and make purchases. It would have been obvious to one of ordinary skill in the art at

the time of the invention to have charged users a fee ... associated with the targeted offering of promotions and to have waived or refunded fees if the users make purchases using the system. This step of charging a user fee is taken to include notification of the required fee, prompting for such fee, submission of the fee/fee payment information , collection of the fee/fee payment information and delivery of the incentive in association with the fee.”

This is tantamount to taking official notice of obviousness of all the claims elements that could not be rejected based on the collective teachings of the applied references. While it may be true that “charging fees” in the abstract is not an innovation, the claim specifically requires prompting a user for payment of a user fee associated with disbursement of a redeemable certificate related to the incentive data file. Thus, it ties into the limitations of method step (e). Thus, for this reason as well as the reasons discussed in the context of claim step (e), Applicants submit that the Examiner has failed to establish a prima facie case of obviousness against claim 1. Accordingly, Applicants submit that claim 1 and its corresponding dependent claims, claims 2-6 are patentable over the combination of applied references.

ii. Claims 7-12

In relevant portion, claim 7 recites, a method comprising, *inter alia*,

e) selecting by the user at the remote terminal a desired good or service and transmitting a request to the central location to receive information related to available incentives associated with the selected good or service;

f) comparing at the central location predetermined incentive qualification criteria with user input data to determine which if any of the group of incentives relates to the user selected good or service and whether any such incentive should be made available to the user;

- g) upon determining that the user qualifies for one or more incentives, presenting the one or more qualified incentives available to the user via the remote terminal;
- h) receiving from the user a request for a qualified incentive;
- i) transmitting to the user a prompt for payment of a user fee as a condition to receiving the selected incentive, and, upon receiving payment from the user, transmitting incentive information to enable the user to redeem the selected incentive;

In the rejection, the Examiner fails to suggest where, in either of the references, a user selects a desired good or service and transmits a request to the central location to receive information related to available incentives associated with the selected good or service. The Examiner also fails to suggest where the step of comparing at the central location predetermined incentive qualification criteria with user input data to determine which if any of the group of incentives relates to the user selected good or service **and** whether any such incentive should be made available to the user. Rather, the Examiner states, “Kepecs teaches that the identified user’s profile is used to determine the offers for which the user qualifies (offers are targeted, individualized discounts determined through comparison/matching of users and offers).” The Examiner appears to be asserting that this summary allegation of what is disclosed in Kepecs somehow establishes a prima facie case of obviousness against all the method steps of claim 7. The Examiner has not met his burden in establishing a prima facie case of obviousness against claim 7. Accordingly, Applicants submit that claim 7 and its corresponding dependent claims, claims 2-6 are patentable over the combination of applied references.

iii. Claims 13-17

In relevant portion, claim 13 recites an online system for presenting incentives over a distributed network, comprising, *inter alia*,

the central location further comprising an incentive determination module adapted to compare incentive data and user input data to arrive at one or more incentives available to a remote user, the at least one processor being adapted to process the incentive determination module; and

a remote terminal ... transmitting to the central location incentive request information input by the user, the incentive determination module at the central location comparing the incentive request information received from the remote terminal with a predetermined set of incentive parameters to determine issuance or non-issuance of an incentive offer to the remote user.

In rejecting claim 13, the Examiner has merely lumped the rejection together with that of claims 7, 15, 16, and 17. The Examiner has failed to demonstrate how the incentive determination module that compares incentive data and user input data to arrive at more incentives available to a user, and a transmitting incentive request information, the incentive determination module comparing the incentive request information received from the remote terminal with a predetermined set of incentive parameters to determine issuance or non-issuance. No where is this specific claim structure addressed in the Examiner's rejection. Thus, the Examiner has not met his burden in establishing a prima facie case of obviousness against claim 13. Accordingly, Applicants submit that claim 13 and its corresponding dependent claims, claims 14-17 are patentable over the combination of applied references.

iv. Claims 18-22

In relevant portion, claim 18 recites an online system for presenting remote users with a user interface to create and submit custom incentives, the system comprising, *inter alia*,

... an incentive determination module adapted to compare incentive data and user input data to arrive at one or more incentives available to a remote user;

...

the graphical user interface having an incentive creation module for receiving desired incentive parameters from the remote user, the graphical user interface presenting the remote user with a number of customizable and variable fields for creating a desired incentive, the customizable and variable fields including one or more of the following: product type or model; incentive amount; product accessories or features required or refused by the user; and time period for delivery of product or service;

the remote terminal transmitting to the central location incentive data input by the remote user, whereby a custom incentive is submitted for acceptance to the central location.

The Examiner rejects claim 19 by stating that “Walker *et al.* (‘207) teaches that the system can process the user defined offer and return a modified offer.” No where in Walker is their suggestion of an incentive determination module that compares incentive data and user input to arrive at one or more incentives available to the user. Presumably the Examiner is relying on the ‘543 patent to teach this feature, however, why one would have been motivated to make this combination is unclear. Applicants also note that a request for a desired incentive is completely different than a conditional purchase offer (i.e., if you will sell it to me for \$X, I agree to buy it at that price). Thus, the Examiner has not met his burden in establishing a *prima facie* case of obviousness against claim 18. Accordingly, Applicants submit that claim 18 and its corresponding dependent claims, claims 18-22 are patentable over the combination of applied references.

v. Claims 23-25

In relevant portion claim 23 recites, a method comprising, *inter alia*,

- b) presenting an incentive offer and an associated user fee by the central location to the remote terminal;

- c) displaying the received incentive offer and user fee at the remote terminal, the user inputting user fee payment data via the remote terminal in exchange for receiving the offered incentive;
- d) transmitting the user fee payment data to the central location; and
- e) distributing the incentive associated with the incentive offer for redemption by the remote user upon purchase of the good or service associated with the incentive and incentive offer.

The Examiner has rejected this claim together with claim 1. However, nowhere in the language of the rejection does the Examiner explain where an incentive and user fee are presented to the user, receiving the user fee payment data, and distributing the incentive. Rather, the Examiner states merely that '543 discloses incentives and that it would have been obvious to charge for them. Thus, Applicants submit that the Examiner has failed to establish a prima facie case of obviousness against claim 23. Accordingly, Applicants submit that claim 23 and its corresponding dependent claims, claims 24 and 25 are patentable over the combination of applied references.

vi. Claims 26-28

In relevant portion, claim 26 a method comprising, *inter alia*,

...

- b) ... presenting the user with a graphical user interface to facilitate creation of a user-defined incentive and presenting the user with a user fee associated with submission of the user-defined incentive;
- c) after creating the user-defined incentive, transmitting the user-defined incentive from the remote terminal to the central location along with payment data to consummate payment of the user fee associated with submission of the user-defined incentive;

- d) accessing the user-defined incentive from the central location and determining acceptance or rejection of the requested incentive based at least in part on parameters associated with the user-defined incentive; and
- e) transmitting notification of acceptance or rejection of the user-defined incentive to the remote user and, if accepted, distributing the incentive associated with the incentive offer for redemption by the remote user upon purchase of the good or service associated with the incentive and incentive offer, and, if rejected, voiding the user fee payment submitted with the user-defined incentive

In rejecting claim 26, The Examiner states that “Kepecs (the ‘543 patent) teaches the use of a remote user graphical interface and it would have been obvious to one of ordinary skill at the time of the invention to have used such a GUI interface for users to input the user defined/customized incentive parameters/data fields so as to make the computerized system user-friendly.” In the system of the ‘543 patent users are selecting incentive that they are interested in. They are not creating custom incentives, they are not paying for the custom incentives and they are not determining acceptance or rejection of the requested incentive based at least in part on parameters associated with the user-defined incentive. Finally, in the ‘543 patent users are not receiving notification of acceptance or rejection of the user-defined incentive, and users are not having the user fee payment voided if the incentive offer is rejected. While speaking generally, providing a refund may be none in the general field of commerce when someone returns a product, this generalization fails to provide support for taking official notice that the elements of method step (e) would have been obvious in view of the collective teachings of the ‘543 and ‘207 patents. Thus, Applicants submit that the Examiner has failed to establish a prima facie case of obviousness against claim 26. Accordingly, Applicants submit that claim 26 and its

corresponding dependent claims, claims 27 and 28 are patentable over the combination of applied references

CONCLUSION

In view of the above, it is readily apparent that the present invention as recited in claims 1-28 includes features and limitations that are neither disclosed nor suggested in the applied art. The basis for the obviousness rejection therefore is not technically sound. Appellants, therefore respectfully request that the Board reverse this rejection.

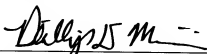
Applicants believe that no charges are due in connection with this amendment. However, in the event Patent Office charges are due, please charge the undersigned's Deposit Account No. 50-0206.

In view of the foregoing, Appellants respectfully request that the Board reverse the prior art rejections set forth in the Office Action, and allow all of the pending claims.

Respectfully submitted,

HUNTON & WILLIAMS

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